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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,426	06/10/2005	Kazuhiro Yagishita	CU-4247 RJS	3191
26530 7590 07/09/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER				
GOLOBY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/538,426

**Applicant(s)**

YAGISHITA, KAZUHIRO

**Examiner**

James Goloboy

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The rejections set forth in the office action mailed 12/10/07 are maintained below. Newly added claims 12-13 are also rejected below.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1, 3-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Katafuchi.

The rejections of claims 1, 3-8, and 10-11 are adequately set forth in paragraph 2 of the office action mailed 12/10/07, which is incorporated here by reference. As discussed in the previous office action, Katafuchi discloses that the salicylate detergent has a TBN of 100 to 600, implying a metal ration that encompasses, falls within, or overlaps the range recited in newly added claim 12. Carrick, in paragraphs 79-80, discloses that the sulfonate detergent can be overbased, and therefore has a metal ration of greater than 1, meeting the limitations of newly added claim 12.

In paragraphs 101-108, Carrick teaches that the antioxidants contained in the composition can be phenolic or aminic antioxidants, as recited in component (E) of newly added claim 13. In paragraphs 109-115, Carrick discloses that the dispersants can be succinimide dispersants (paragraphs 112, 115), as recited in component (D) of claim 13. In paragraphs 116-117, Carrick discloses that the antiwear agents can be sulfur/phosphorus-containing compounds, also as recited in claim 13. The composition of Carrick and Katafuchi therefore meets the limitation of claim 13.

3. Claims 1-2, 4-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Chambard.

The rejection of claims 1-2, 4-8, and 10-11 are adequately set forth in paragraph 3 of the office action mailed 12/10/07, which is incorporated here by reference. As discussed in the previous office action, Chambard discloses that the salicylate detergent has a TBN of 160 to 400, implying a metal ration that encompasses, falls within, or overlaps the range recited in newly added claim 12. Carrick, in paragraphs 79-80, discloses that the sulfonate detergent can be overbased, and therefore has a metal ration of greater than 1, meeting the limitations of newly added claim 12.

In paragraphs 101-108, Carrick teaches that the antioxidants contained in the composition can be phenolic or aminic antioxidants, as recited in component (E) of newly added claim 13. In paragraphs 109-115, Carrick discloses that the dispersants can be succinimide dispersants (paragraphs 112, 115), as recited in component (D) of claim 13. In paragraphs 116-117, Carrick discloses that the antiwear agents can be sulfur/phosphorus-containing compounds, also as recited in claim 13. The composition of Carrick and Chambard therefore meets the limitation of claim 13.

4. Claims 1-3, 5-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Tamoto.

This rejection is adequately set forth in paragraph 4 of the office action mailed 12/10/07, which is incorporated here by reference.

In paragraphs 101-108, Carrick teaches that the antioxidants contained in the composition can be phenolic or aminic antioxidants, as recited in component (E) of newly added claim 13. In paragraphs 109-115, Carrick discloses that the dispersants can be succinimide dispersants (paragraphs 112, 115), as recited in component (D) of claim 13. In paragraphs 116-117, Carrick discloses that the antiwear agents can be sulfur/phosphorus-containing compounds, also as recited in claim 13. The composition of Carrick and Tamoto therefore meets the limitation of claim 13.

#### ***Response to Arguments***

5. Applicant's arguments filed 3/26/08 have been fully considered but they are not persuasive. Applicant argues that the cited references do not specify the positions of the alkyl substituents of the salicylate. However, given the small number of possibilities for the positions of the two alkyl groups, it is as if the specific claimed compound were disclosed, and the claim is therefore rendered obvious. Applicant also argues that Tamoto does not disclose the specific combination of hydrocarbon groups recited in claim 9. As stated in the previous office action, Tamoto discloses a range of carbon atoms for the alkyl groups that encompasses or overlaps the both ranges recited in the claim, and therefore renders the claim obvious.

#### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797